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In re Application of
BIESCHKE et al.
Application No.: 10/089,233
PCT No.: PCT/EP00/09468
Int. Filing Date: 28 September 2000
Priority Date: 28 September 1999
Attorney Docket No.: P67758US0
For: QUANTITATIVE ANALYSIS AND
TYPIIFICATION OF SUBCELLULAR
PARTICLES

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: DECISION ON REQUEST
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: UNDER 37 CFR 1.137(b)
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This is a decision on applicants' "Petition to Revive Under 37 CFR 1.137(b)" filed on 02 February 2005 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 19 June 2002, a Notification of Missing Requirements was mailed to applicants, indicating that an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), an English translation of the international application and the processing fee for filing the translation after the thirty month period, was required.

On 19 December 2002, in response to the Notification of Missing Requirements, applicants filed a request for a four month extension of time and an executed declaration, identifying PCT/EP00/09468. The declaration named Jan Bieschke, Armin Giese, Manfred Eigen as inventive entities. A second page listed only Hans A. Kretzschmar as an inventive entity. The declaration was executed by the inventors named in the international application publication and by Messrs. Eigen and Kretzschmar, who were not named as inventors in the published international application.

On 06 February 2003, a Notification of Defective Response was mailed to applicants indicating that the declaration executed by the inventors did not comply with 37 CFR 1.497(a) and (b) because the declaration was executed by the inventors, not listed in the International Application and without documents to support the addition.

On 06 March 2003, Petitioner filed a response, treated as a request to correct inventorship under 37 CFR 1.497(d), to add inventors Manfred Eigen and Hans A. Kretzschmar. Petitioner provided statements of Messrs. Eigen and Kretzschmar in support of the correction of inventorship under 37 CFR 1.497(d) and the apparent written consent of the assignee. However, Petitioner did not provide a new declaration in compliance with 37 CFR 1.497(a) & (b).

On 08 July 2003, a decision on petition under 37 CFR 1.497 was mailed to applicant indicating that the requisite \$130 fee and the \$130 surcharge for filing the declaration after the 30 month period were paid. However, since a declaration in compliance with 37 CFR 1.497 was not presented with applicant's Response to the Notification of Defective Response, the application was abandoned. Furthermore, the Consent of Assignee did not satisfy 37 CFR 1.497.

On 02 February 2004, applicant filed a Petition to Revive along with a declaration of the

inventors, and consent of assignee under 37 CFR 1.497(d)(3).

DISCUSSION

Petitioner submitted four newly executed declarations. The declarations meet the requirements of 37 CFR 1.497(a) & (b); that is, the declarations identify all the inventors.

As stated in the previous decision, where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) written consent of the assignee, if an assignment has been executed by any of the original named inventors. Applicant has previously satisfied Item (1) and (2). With regard to Item (3), applicant has submitted the new written consent of the assignee as required to correct the inventorship.

Only a copy of the assignment executed by added inventor Manfred Eigen is located among the USPTO records. It is assumed that no other assignments have been executed. If this assumption is incorrect, applicant must notify the Office immediately and provide such executed assignments. Applicant has now met all of the requirements under 37 CFR 1.497(d) for correction of inventorship.

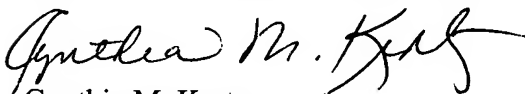
A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper response unless it has been previously submitted, (2) the fee required by law for revival of an unintentionally abandoned application (1.17(m)), and (3) a statement that the "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional".

The proper response, that is, the declarations executed by the inventors and the written consent of the assignee has been submitted. A review of the application file reveals that the required petition fee has also been paid. However, applicant has not satisfied item (3) with an appropriate statement regarding the "entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition" under 37 CFR 1.137(b)(3). Thus, the requirements of 37 CFR 1.137(b) have not been met.

CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED**. The petition under 37 CFR 1.137(b) is **DISMISSED WITHOUT PREJUDICE**. The application remains **ABANDONED**.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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